

REMARKS

Initially, Applicant would like to express appreciation to the Examiner for the detailed Official Action provided, for the acknowledgment of Applicant's Claim for Priority and receipt of the certified copy of the priority document, and for the acknowledgment of Applicant's Information Disclosure Statement by return of the Form PTO-1449. However, Applicant notes that the Examiner has not indicated that the drawings have been approved by the Official Draftsperson on a Form PTO-948. The Examiner is thus requested to indicate that Applicant's drawings are acceptable in the next Official Action. Additionally, Applicant notes that the Form PTO 1449 returned with the Office Action did not have the Examiner's initials adjacent the English language abstract of the Japanese document. While it is presumed that the Examiner considered the English language abstract when considering the underlying document, nevertheless, Applicant respectfully requests that the Examiner initial the Form PTO 1449 beside the English language abstract to indicate consideration thereof, and return a copy of the initialed Form PTO 1449 with the next Official Action.

Upon entry of the above amendment, claims 1 and 5 will have been amended. Accordingly, claims 1-22 are currently pending. Applicant respectfully requests reconsideration of the outstanding rejections and allowance of claims 1-22 in the present application. Such action is respectfully requested and is now believed to be appropriate and

The Examiner has rejected claim 5 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner has rejected claim 5 under 35 U.S.C. § 112, second paragraph, as the phrase "said connecting pieces" renders the claim indefinite. In response thereto, Applicant has amended claim 5 to include the phrase "wherein said at least one elastic connecting piece comprises a pair of elastic connecting pieces provided on said internal terminal". Accordingly, in view of the above noted amendments and remarks, claim 5 is believed to fully comply with 35 U.S.C. § 112, second paragraph, and Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection under 35 U.S.C. § 112, second paragraph.

The Examiner has rejected claims 1, 4-13, and 15-21 under 35 U.S.C. § 102(b) as being anticipated by AOYAMA et al. (U.S. Patent No. 6,210,223). The Examiner takes the position that AOYAMA et al. discloses a shielded connector assembly and a method for assembling a female shielded terminal including an internal terminal 20b having at least one elastic connecting piece 100, a dielectric 30b insulating the internal terminal 20b from an external terminal 40b, and thrusting pieces 23.

As an initial matter, Applicant respectfully submits that the AOYAMA et al. patent is not available as prior art under 35 U.S.C. 102(b). In this regard, Applicant notes that the

the United States Patent and Trademark Office on November 21, 2001. Since the AOYAMA et al. patent did not issue more than one year prior to the date of application for patent in the United States in the present application, the AOYAMA et al. patent is not available as prior art under 35 U.S.C. § 102(b). Therefore, the rejection of claims 1, 4-13, and 15-21 under 35 U.S.C. § 102(b) over AOYAMA et al. is at least improper due to the unavailability of the AOYAMA et al. patent as prior art under 35 U.S.C. § 102(b). Accordingly, the withdrawal of such rejection is respectfully requested.

Although the rejection should be withdrawn for the reasons set forth above regarding the unavailability of the AOYAMA et al. patent as prior art under 35 U.S.C. § 102(b), the following comments regarding the merits of the rejection and the disclosure of the AOYAMA et al. reference are provided in order to expedite the prosecution of the present application toward allowance.

Although Applicant does not necessarily agree with the Examiner's rejection of the claims on this ground, nevertheless, Applicant has amended independent claim 1 to clearly obviate the above noted ground of rejection in order to expedite prosecution of the present application. In this regard, Applicant notes that AOYAMA et al. fails to show each and every element recited in the independent claims. In particular, claim 1, as amended, sets forth an assembly for a female shielded terminal including, inter alia, "an internal terminal

terminal including at least one elastic connecting piece to contact a corresponding male terminal, said internal terminal remaining unconnected to a shielded electric wire". Claim 12 sets forth a method for assembling a female shielded terminal including, inter alia, "mounting a dielectric on an outer periphery of said internal terminal; after mounting said dielectric on said internal terminal, connecting said inner conductor of said shielded electric wire to said internal terminal". Claim 22 sets forth a method for assembling a female shielded terminal including, inter alia, "after mounting said external terminal on said dielectric and said internal terminal therein, simultaneously connecting said inner conductor of said shielded electric wire to said internal terminal and connecting said external terminal to said outer conductor of said shielded electric wire.". The AOYAMA et al. patent discloses an assembly for a female shielded terminal including an internal terminal 20b and a dielectric 30b mounted on the outer periphery of the internal terminal 20b, an external terminal 40b, and a method for assembling the female shielded terminal. The female shielded terminal of AOYAMA et al. is assembled by first connecting the inner terminal 20b to the conductor 51 of the shielded electric wire, then inserting the dielectric element 30b into the outer terminal 40a, and subsequently connecting the inner terminal 20b and the outer terminal 40b. See particularly column 4, lines 13-18 and column 5, line 38 through column 6, line 2. Thus, in the AOYAMA et al. method, the conductor 51 of the shielded electric wire is connected to

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Thus, AOYAMA et al. fails to disclose a method of assembling a female shielded terminal including, inter alia, "after mounting said dielectric on said internal terminal, connecting said inner conductor of said shielded electric wire to said internal terminal" as recited in claim 12, and "after mounting said external terminal on said dielectric and said internal terminal therein, simultaneously connecting said inner conductor of said shielded electric wire to said internal terminal and connecting said external terminal to said outer conductor of said shielded electric wire" as recited in claim 22. Further, in the AOYAMA et al. device, partially through the steps of assembling the female shielded terminal, the conductor of the shielded electric wire is connected to the inner terminal, and the dielectric element is connected to the outer terminal. Thus, AOYAMA et al. fails to disclose an assembly for a female shielded terminal including, inter alia, "an internal terminal configured to be connectable to an inner conductor of a shielded electric wire, said internal terminal including at least one elastic connecting piece to contact a corresponding male terminal, said internal terminal remaining unconnected to a shielded electric wire" as recited in amended claim 1. Since the reference fails to show each and every element of the claimed device and method, the rejection of claims 1, 4-13, and 15-21 under 35 U.S.C. § 102(b) over AOYAMA et al. is improper and withdrawal thereof is respectfully requested.

The Examiner has rejected claims 2, 3, and 14 under 35 U.S.C. § 103(a) as being

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the position that AOYAMA et al. shows a shielded connector assembly but does not disclose cantilevered connecting pieces configured in an L-shape. The Examiner contends that it would have been obvious to modify the internal terminal of AOYAMA et al. to include the internal terminal configuration of SEKO et al. to overcome difficulties in the prior art and to prevent foreign matter from entering the bending space of the terminal fitting.

However, it is pointed out that AOYAMA et al. (U.S. Patent No. 6,210,223) does not qualify as prior art against the present application for purposes of a rejection under 35 U.S.C. § 103(a) due to common ownership with the present application. See 35 U.S.C. § 103(c). It is noted that the AOYAMA et al. patent issued from U.S. Application No. 09/444,279 which was filed on November 19, 1999, prior to the filing date of the present application on November 21, 2001, and prior to the 35 U.S.C. § 119 priority date of the present application which is January 5, 2001. However, the AOYAMA et al. patent issued on April 3, 2001, less than one year before the filing date of the present application. Therefore, notwithstanding the Examiner's rejection of claims 1, 4-13, and 15-21 under 35 U.S.C. § 102(b) over AOYAMA et al. (see discussion above), it appears that the AOYAMA et al. patent was applied in the Official Action as a 102(e) 103 reference.

As pointed out above, the AOYAMA et al. reference is not available for use as prior art against the present application for purposes of a rejection under 35 U.S.C. § 103(a) due

[Signature] [Name] [Title] [Firm Name]

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U.S. Patent No. 6,210,223, were, at the time the invention of the present Application No. 09/989,145 was made, owned by SUMITOMO WIRING SYSTEMS, LTD. It is noted that an Assignment of the invention of the present Application No. 09/989,145 to SUMITOMO WIRING SYSTEMS, LTD. was recorded at Reel 012314, Frame 0747. Therefore, the rejection of claims 2, 3, and 14 under 35 U.S.C. § 103(a) as being unpatentable over AOYAMA et al. in view of SEKO et al. is at least improper due to the unavailability of the AOYAMA et al. patent as prior art. Accordingly, the withdrawal of such rejection is respectfully requested.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of all the rejections, and an early indication of the allowance of claims 1-22.

SUMMARY AND CONCLUSION

In view of the foregoing, it is submitted that the present amendment is proper and that none of the references of record, considered alone or in any proper combination thereof, anticipate or render obvious Applicant's invention as recited in claims 1-22. The applied references of record have been discussed and distinguished, while significant claimed features of the present invention have been pointed out.

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Accordingly, consideration of the present amendment, reconsideration of the outstanding Official Action, and allowance of the present amendment and all of the claims therein are respectfully requested and now believed to be appropriate.

Applicant has made a sincere effort to place the present application in condition for allowance and believe that they have now done so.

Applicant notes that this amendment is being made to advance prosecution of the application to allowance, and should not be considered as surrendering equivalents of the territory between the claims prior to the present amendment and the amended claims.

Should there be any questions, the Examiner is invited to contact the undersigned at the below listed number.

Respectfully submitted,
Kazuhiko NIMURA

Will E. Lydell Esq. No.
Bruce H. Bernstein 41,368
Reg. No. 29,027

March 17, 2003
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, Virginia 20191
(703) 716-1191

MARKED UP COPY OF CLAIM AMENDMENTS

1. (Amended) An assembly for a female shielded terminal, said assembly comprising:
an internal terminal configured to be connectable to an inner conductor of a shielded electric wire, said internal terminal including at least one elastic connecting piece to contact a corresponding male terminal, said internal terminal remaining unconnected to a shielded electric wire; and

a dielectric mounted on an outer periphery of said internal terminal to insulate said internal terminal from an external terminal connected to an outer conductor of the shielded electric wire.

5. (Amended) The assembly for a female shielded terminal according to claim 4,
wherein said at least one elastic connecting piece comprises a pair of elastic connecting pieces provided on said internal terminal, and

wherein said hole is dimensioned to allow movement of said connecting pieces toward and away from each other.